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Benoit Pol Menez

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EXAMINER

VAN HANDEL, MICHAEL P

ART UNIT

PAPER NUMBER

2623

DATE MAILED: 09/14/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

10/020,713

Applicant(s)

MENEZ, BENOIT POL

Examiner

Michael Van Handel

Art Unit

2623

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 10 July 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_.

## DETAILED ACTION

### *Response to Amendment*

1. This action is responsive to an Amendment filed 7/10/2006. Claims **1-26** are pending.

Claims **1, 13, 14, 26** are amended.

### *Response to Arguments*

1. Applicant's arguments, filed 7/10/2006, with regard to claims **1, 13, 14, and 26** have been fully considered, but they are not persuasive.

Regarding claims **1** and **14**, the applicant argues that Lewis does not disclose preventing an item from being stored to a storage format that was not selected (between a magnetic storage and an optical disc based medium); however, the examiner notes that the applicant lacks support for this particular limitation in the specification. The examiner acknowledges that the specification discloses allowing consumers to download a copy of a program for storage on a local device, for example a magnetic data store or other optical device (p. 2, l. 17-18). The examiner further acknowledges that the specification discloses that one or more, if not all, of the communications among the various components of Figure 1 can be encrypted (p. 9, l. 7-12). The examiner notes; however, that the specification fails to disclose selecting between a magnetic based storage device and an optical based disc storage and restricting the item from being stored in the medium that was not selected. As such, the examiner finds the newly added limitation be new matter, thereby rendering the applicant's argument moot.

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Regarding claims **13** and **26**, the applicant argues that no new matter was added in the limitations. The examiner respectfully disagrees. Claim 13 recites “wherein said item is encrypted to prevent said item from being stored for the physical medium that was not selected” and claim 26 recites “wherein said item is encrypted as to prevent the storage of said item in a storage format that was not selected at the time of purchase.” The applicant cites p. 2, lines 13-18 and p. 9, lines 2-12 in support of the limitation. The examiner notes that the specification fails to disclose selecting between a magnetic based storage device and an optical based disc storage and restricting the item from being stored in the medium that was not selected (see above). The examiner acknowledges that the specification discloses that one or more, if not all, of the communications among the various components of Figure 1 can be encrypted, and that the communications among the components can be authenticated on the sending side, the receiving side, or on both sides of each communication. This encryption does not necessarily “prevent said item from being stored for the physical medium that was not selected” or “prevent the storage of said item in a storage format that was not selected at the time of purchase” as recited in the newly added claim limitations. As such, the examiner finds the newly added limitations to be new matter, thereby rendering the applicant’s argument moot.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

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3. Claims **1**, **13**, **14**, and **26** are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Specifically, claim **1** recites the limitation “storing said item in the selected physical medium, wherein said item is restricted from being stored in physical medium that was not selected.”

Claim **13** recites the limitation “wherein said item is encrypted to prevent said item from being stored for the physical medium that was not selected.”

Claim **14** recites the limitation “wherein said item is prevented from being stored in other storage formats that are capable of being selected at the time of purchase and additional copies of said item can be made is said selected storage format.”

Claim **26** recites the limitation “wherein said item is encrypted as to prevent the storage of said item in a storage format that was not selected at the time of purchase.”

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims **1-5, 7-12, 14-18, 20-25** are rejected under 35 U.S.C. 102(e) as being anticipated by Lewis.

Referring to claims **1, 3, 4, 10, 14, 16, 17, and 23**, Lewis discloses a method of providing a program, comprising:

- a) sending electronic program guide information through a network to a receiver (p. 20, paragraph 203), said electronic program guide information comprising at least one selectable program identifier for initiating a purchase transaction for an item associated with said selectable program identifier (p. 9, paragraph 92)(Figs. 3A-3C);
- b) presenting said selectable program identifier;
- c) responsive to a selection of said program identifier, establishing a computer communications link between said receiver and at least one remote server (p. 12, paragraph 126)(Fig. 4);
- d) downloading from said remote server said item after being purchased wherein during said purchase transaction the item is selected as being capable of being stored for the physical medium of a magnetic based storage device or for a physical medium of a optical based disc storage device (p. 7, paragraph 76);

Referring to claim **10**, Lewis discloses presenting an electronic order form for said sale of said item associated with said selected program identifier, and uploading said electronic order form to said remote server via said computer communications link (Fig. 3C).

Referring to claim **14**, Lewis discloses selecting a storage format at the time of purchase and storing the item in the selected storage format (p. 20, paragraph 204).

Referring to claims **2** and **15**, Lewis discloses the methods of claims 1 and 14, respectively, wherein said electronic program guide information is stored in said digital television receiver and includes information associated with programs previously broadcast for a predetermined time period (Lewis discloses that the user locates the starting point of the broadcast program which has been recorded on the system's built-in storage device through program menu displays on the VPR/DMS. Lewis further discloses that the user can scan backwards all broadcasts received within a limited time period)(p. 23, paragraph 241).

Referring to claims **5** and **18**, Lewis discloses the methods of claims 1 and 14, respectively, further comprising: determining said potential purchase transactions by querying, through said computer communications link, a plurality of additional remote servers, wherein selected ones of said plurality of remote servers are associated with different registered vendors (p. 12, paragraph 126).

Referring to claims **7**, **8**, **20**, and **21**, Lewis discloses the methods of claims 1 and 14, further comprising:  
receiving said selected purchase transaction at said remote server through said computer communications link (p. 12, paragraph 132).

Referring to claims **9** and **22**, Lewis discloses the methods of claims 8 and 21, respectively, further comprising:  
billing a consumer account for said purchase transaction (p. 10, paragraph 98).

Referring to claims **11** and **24**, Lewis discloses the methods of claims 1 and 14, respectively, wherein said computer communications link is an Internet connection (p. 14, paragraph 151)(Fig. 6).

Referring to claims **12** and **25**, Lewis discloses the methods of claims 1 and 14, wherein said item associated with said program identifier is a copy of said program in a physical medium (p. 21, paragraphs 213, 214, 215)(p. 25, paragraph 256).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims **6** and **19** are rejected under 35 U.S.C. 103(a) as being unpatentable over Lewis.

Referring to claims **6** and **19**, Lewis discloses the methods of claims 5 and 18, respectively.

Lewis further discloses debiting payment from a user account (p. 11, paragraph 116). Lewis does not disclose recalculating potential purchase transactions to include a service fee. The examiner takes Official Notice that it is well known within the prior art to update an electronic order form to reflect additional costs associated with the purchase. It would have been obvious to one of ordinary skill in the art at the time that the invention was made to modify Lewis to update a payment screen to reflect additional costs associated with a purchase such as that taught



by the prior art in order to inform a customer of the total amount that will be charged to their credit, checking, or debit accounts.

***Conclusion***

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Michael Van Handel whose telephone number is 571.272.5968. The examiner can normally be reached on Monday-Friday, 8:00am-5:30pm.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Chris Kelley can be reached on 571.272.7331. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

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Art Unit 2623

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